

REMARKS

In view of the Office Action mailed 12/11/09, Applicant respectfully traverses the rejections as follows:

THE SECTION 112 OBJECTION AND 101 REJECTION

Applicant has amended the claims and submits that the amendment overcomes the Section 112 and 101 rejections/objections. Claim 1 previously recited the patent office computer and now recites the local computer as well as displaying deadlines for dockets. Similarly, claims 19, 22 and 23 now recite local computer and displaying documents downloaded from the patent office computer. The transformation is recited in the claims. The amendment is purely to address the Section 101 and not due to the prior art. Withdrawal of the objection/rejection is requested.

THE SECTION 102 REJECTIONS

Claims 1-12 and 14-17 were rejected under Section 102(b) as anticipated by Granger 20020161733. Applicant respectfully traverses the rejection.

The Office Action notes that Grainger I's [42] and [120] shows the downloading one or more file wrapper documents associated with the new docket item(s) from the patent office computer to the local database. However, [42] simply relates to Web pages uniquely identifiable by a Uniform Resource Locator (URL) and stored in a computer-readable memory (not shown) accessible to the server engine. [120] also fails to show the specifics of downloading file wrapper document from patent office computer to a local computer:

[0120] Also shown in FIG. 4F are upload, create and submit icons 230 a , 230 b and 230 c . Selecting upload icon 230 a allows a client system to upload a document that was not originally created through IP data processing system 100 into the system. Create icon 230 b , on the other hand, allows the client system to initiate creation of a new document, such as a new patent application from an already filed Invention Disclosure or a new Amendment after receiving an Office Action. When create icon 230 b is selected, all fields that can be populated with data already in database 106 are so populated

Further, Grainger I fails to show automatically adding a docket entry with a deadline for each new docket item and displaying the deadline based on a downloaded file wrapper document.

For the above three separate reasons, Grainger cannot anticipate claims 1 and those dependent therefrom. Moreover, Grainger fails to show the specifics of the dependent claims 2-12 and 14-17, and this is another basis of traversing the Section 102 rejection. Applicant traverses the Office Action determination that words in the claims with specific meaning such as mail-room date and document description as “non-functional descriptive material.” TO the contrary, these words are specific items that are to be accorded weight and can’t simply be ignored. Withdrawal of the rejection on these claims is respectfully requested.

Claims 19-22 were rejected over Grainger 2. However, Applicant has read Grainger 2 carefully and fails to find searching one or more databases on a computer for one or more relevant IPs to an owner of a predetermined IP; performing a network analysis on the relevant IPs; and determining and displaying IPs infringed by the owner of the predetermined IP. Withdrawal of the rejection on claim 19 and dependent claims 20-22 is respectfully requested.

Claims 22-24 were rejected under Section 102 as anticipated by PAIR. However, PAIR does not retrieve file wrapper history for a plurality of cases recited in a computer readable list. Further, PAIR does not receive an application serial number conforming to a format aa/bbbbb; and determine a published patent application matching the bbbbb. Rather, Applicant believes that PAIR uses both the aa code and the bbbbb code to locate a document. Further, PAIR does not automatically downloading file wrapper history for each case in the list as one or more PDF documents to a computer.

In the invention, the file history download for a number of cases is done automatically by the computer programmed in accordance with the invention without manual operator intervention. The systems of claim 22-23 programmatically automates this task for the user so that he/she can retrieve information on specified cases without having to click on buttons in each case to download. This enables seamless checking of the user's cases and can be done automatically without the user even being present.

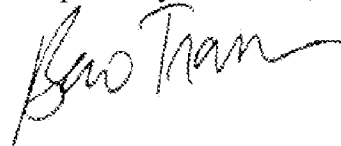
Hence, the system as claimed differs from PAIR, which is intended for manual human operation.

Withdrawal of the rejection is respectfully requested.

CONCLUSION

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 408-528-7490.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Bao Tran", with a stylized, cursive script.

Bao Tran
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